

**PATENT**  
Docket No. 77792/23

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant : Koji SATO, et al.  
Application No. 08/750,641  
Filing Date : 16 December 1996  
Title : SCHEDULE SETTING AND PROCESSING SYSTEM  
Art Unit : Office of Petitions  
Examiner : L. Walsh

**ATTENTION: PETITIONS BRANCH**

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**SECOND RENEWED PETITION UNDER 37 CFR 1.137(b)**

SIR:

This second renewed petition for revival of United States Application No. 08/750,641 (“641”) abandoned unintentionally (“Second Renewed Petition”), and an accompanying one (1) month extension of time, is in response to the second petition dismissal (“Second Dismissal”) mailed by the USPTO on April 17, 2009. Favorable consideration of this petition is respectfully requested.

A summary of the additional information and documents required in the Second Dismissal begins on page 2.

A response specific to the Second Dismissal begins on page 3.

Background facts and law begin on page 7.

Discussion of the facts and law begins on page 25.

A conclusion and a summary of petition contents begins on page 27.

## **SUMMARY OF USPTO REQUIREMENTS IMPOSED IN SECOND DISMISSAL**

According to the Second Dismissal, Applicants' submission of December 10, 2008 ("First Renewed Petition") "lacks items (1) and (3)," i.e., "(1) the required reply, unless previously filed" and "(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." (Second Dismissal at 1.) The Second Dismissal also indicates that "more information is required [specifically for] the timeframe from 2004 to 2008. Petitioner is required to explain in detail the delay from the filing of the Information Disclosure Statement on September 10, 2004 until the filing of the petition on August 6, 2008." Clarification regarding power of attorney for the application at issue was also requested.

It is noted that a first petition dismissal ("Dismissal") was mailed by the USPTO on September 10, 2008, and that the Dismissal similarly found that Applicants' original petition filed August 6, 2008 ("Original Petition") lacked a "required reply" and "a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." (Dismissal at 1.) The Dismissal also indicated that "there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional." (*Id.*) Accordingly, the Dismissal requested further information as to "the delay in reply that originally resulted in the abandonment" and "the delay in filing an initial petition pursuant to 37 CFR 1.137(b) to revive the application."

## **RESPONSE TO PARTICULAR ISSUES RAISED IN SECOND DISMISSAL**

Applicants' respectfully submit that their First Renewed Petition contained "items (1) and (3)," i.e., "(1) the required reply, unless previously filed" and "(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." These items are included in this Second Renewed Petition for the Examiner's convenience.

Applicants' also respectfully submit that their First Renewed Petition contained sufficient detail regarding the 2004-08 time period. Nevertheless, to further address the Office's concerns, this Second Renewed Petition reorganizes previously presented information to address the September 10, 2004 to August 6, 2008 period of question.

Pursuant to the Office's comments in the Second Dismissal, clarified Power of Attorney information has been filed with the USPTO.

In further response to the Office's concerns, this Second Renewed Petition newly provides a declaration from a former Kenyon attorney, William E. Curry, who, in the 2003-2004 timeframe, filed a Request for Status and two Information Disclosure Statements. Accordingly, this Second Renewed Petition now contains five (5) declarations from registered patent attorneys who were at some time involved in the prosecution and/or attempts to determine the disposition of '641. As evidenced by these five declarations, as well as two others from Kenyon staff, Kenyon and its attorneys believed that at all times it had met all outstanding Office requirements, and that the next action was to be taken by the USPTO. Any delay in discovering the abandoned status of the '641 application was unfortunate, but completely unintentional. Factors contributing to delay in the period after September 10, 2004 include:

1) In or about March of 1999, Kenyon's Washington, DC office experienced its first (and only) change of address.<sup>1</sup> At that time, Kenyon moved its DC office from 1025 Connecticut Avenue, NW, to 1500 K Street, NW. (O'Dowd Decl. ¶ 19.) While Kenyon was eventually able to change the correspondence address for the many applications then handled by Kenyon's Washington, DC office, as of March of 2000, the USPTO did not recognize the correspondence address of '641 as being 1500 K Street, NW.<sup>2</sup> Correspondingly, as is clearly evidenced by a paper in the USPTO's paper file, Applicants did not receive a Notice of Allowability for '641 which was mailed on April 17, 2000 (Paper #16). (O'Dowd Decl. ¶ 26.) Subsequently, the '641 application went abandoned, as evidenced by a Notice of Abandonment mailed by the USPTO on September 13, 2000 (Paper #17). (O'Dowd Decl. ¶ 30.)

2) In 2000, two key Kenyon attorneys left the firm. The Kenyon partner to whom '641 USPTO correspondence was addressed, Frank Pietrantonio, left employment with Kenyon on May 1, 2000. (O'Dowd Decl. ¶ 13.) In addition, the associate who appeared to have performed all of the prosecution work for '641, Sterlon Mason, left Kenyon on July 21, 2000. (O'Dowd Decl. ¶ 12.) The departure of these attorneys greatly reduced Kenyon's institutional knowledge regarding '641.

3) In 2000, the USPTO temporarily lost the '641 file. According to a note in Kenyon's '641 paper file, the USPTO reported the '641 file as lost on November 27, 2000. (O'Dowd Decl. ¶ 39.) Additional evidence that the '641 paper file was lost is provided by Paper #19 in the

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<sup>1</sup> A March 1999 move date is partially evidenced by comparing Paper #8 and Paper #10 of the '641 application. Paper #8, received by the USPTO on March 17, 1999, uses the 1025 Connecticut Avenue NW address. Paper #10, received by the USPTO on October 12, 1999, uses the 1500 K Street NW address. The March 1999 move date is also evidenced by the undeliverability of the April 17, 2000 Notice of Allowability (Paper #17), as evidenced by a paper stamped April 27, 2000 in the USPTO's '641 paper file. It is well known that the United States Postal Service (USPS) ceases the forwarding of mail one year after a move date. While Paper #17 was not forwarded to Kenyon's 1500 K Street NW address, an advisory action dated February 29, 2000 (Paper #13) was received by Kenyon, presumably from the USPS.

<sup>2</sup> However, by that time, Papers #10, 12, 14, and 15 had been filed bearing the 1500 K Street NW address.

USPTO's '641 file wrapper, i.e., while the Change of Correspondence Address document given the designation of Paper #19 is dated October 30, 2000, it was not entered until June 12 of some undetermined year (presumably 2001, 2002, or 2003). Kenyon was orally informed of the loss of the '641 file on January 12, 2001. (O'Dowd Decl. ¶ 39.) To confirm the loss of the file, on or about February 8, 2001, at least one of two Kenyon staff members having a Power to Inspect and Make Copies (signed by John C. Altmiller) personally traveled to the USPTO in an unsuccessful attempt to inspect the USPTO paper file. (O'Dowd Decl. ¶ 40.) Subsequently, a File Reconstruction request, including a copy of the application as filed, was provided on or about March 23, 2001 to the USPTO by Mark H. Neblett of Kenyon. (Neblett Decl. ¶¶ 5-7.)

- 4) In 2003 and 2004, the USPTO failed to respond to two Status Inquiry requests filed by Kenyon attorneys. (O'Dowd Decl. ¶¶ 45-47, 52-53; Altmiller Decl. ¶ 22.) These requests were filed on September 8, 2003 (signed by John C. Altmiller) and on September 15, 2004 (signed by William Curry). (*Id.*)
- 5) In or about 2004, most or all of the co-pending applications related to '641 were allowed by foreign patent offices. While these related foreign applications were pending, Kenyon would periodically receive prior art from these foreign prosecutions which triggered the necessity of filing an Information Disclosure Statement (IDS). For example, an IDS was filed by Kenyon on September 9, 2004 which provided "references cited in the European Search Report of a related European Patent Application." (See O'Dowd Decl. ¶ 51.) It is believed that the filing of this IDS prompted the filing of the September 15, 2004 status request by William Curry. (See O'Dowd Decl. ¶ 52.)

6) In early 2007, William E. Curry and John C. Altmiller ceased employment with Kenyon. (*See* O'Dowd Decl. ¶¶ 54-55.) Again, institutional knowledge regarding '641 was lost to Applicants.

7) Kenyon's electronic docketing system categorized the loss of the file by the USPTO as "PTO lost file-awaiting OA." (Russo Decl. ¶ 5.) Such has been the status of '641 in Kenyon's electronic docketing system since at least July 15, 2002. (*Id.*) Such a status conveys to a prosecuting attorney, particularly a prosecuting attorney having no prior knowledge of '641, that no action need be taken since the USPTO is attempting to find and/or reconstruct the file. (Russo Decl. ¶ 6.) Furthermore, because the attorney is only "awaiting" an office action, there is nothing in the description to prompt the attorney to take immediate action.

## **BACKGROUND FACTS AND LAW<sup>3</sup>**

**This Second Renewed Petition Meets At Least the Minimum Requirements Under 37 CFR 1.137(b).**

As specified in the Dismissal:

A grantable petition under 37 CFR 1.137(b) must be accompanied by:

- (1) the required reply,
- (2) the petition fee,
- (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137 was unintentional, and
- (4) a terminal disclaimer and fee if the application was filed on or before June 8, 1995 or if the application is a design application.

(Dismissal at 1.)

As to minimum requirement (1), this renewed petition contains the “required reply,” i.e., the payment of the issue fee for United States Application No. 08/750,641 (“‘641”), as well as replacement formal drawing sheets.<sup>4</sup>

Regarding minimum requirement (2), the proper petition fee was paid with the Original Petition.

Concerning minimum requirement (3), Applicants’ affirmatively state that the entire delay in filing the required reply for ‘641 from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional.

As to minimum requirement (4), ‘641, a utility application, was filed after June 8, 1995, and is thus not subject to the terminal disclaimer requirement.

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<sup>3</sup> This section is essentially identical to information already provided to the Office in the First Renewed Petition. The Examiner, however, is directed to some minor changes made in ¶¶ 30-35, i.e., paragraphs relating to the Status Requests and the Information Disclosure Statements filed by William E. Curry, and ¶¶ 49-53, which relate to the Second Dismissal and the filing of this Second Renewed Petition.

<sup>4</sup> Figures 1 and 13 are corrected by moving the legend to under the figure, as requested in the PTO-948. Figures 15(A) and 15(B) are corrected by moving the figure such that a 2.5 cm upper margin is obtained. Annotated original sheets are included, along with replacement sheets.

Accordingly, Applicants' respectfully submit that the minimum requirements for a grantable petition under 37 CFR 1.137(b) have been met, and that the USPTO should exercise its discretion in favor of granting this renewed petition.

**There is no legal requirement that the USPTO consider additional information for the granting of this Second Renewed Petition.**

37 CFR 1.137(b) specifies that “[t]he Director may require additional information where there is a question whether the delay was unintentional” (emphasis added). By the use of the term “may,” 37 CFR 1.137(b) clearly indicates that there is no affirmative legal requirement for the USPTO to require additional information in any petition filed under the 1.137(b) unintentional standard, let alone, this Second Renewed Petition.

**The MPEP indicates that Petitions Examiners have the discretion to require additional information for the granting of petitions under 37 CFR 1.137(b), but are not mandated to do so.**

As set forth in MPEP 711.03(c)(III)(D), “[w]here a petition pursuant to 37 CFR 1.137(b) is not filed within 1 year of the date of abandonment of the application . . . the Office may require [further information and showings]” (emphasis added). This is in contrast to petitions filed under the unavoidable standard. For petitions filed under 37 CFR 1.137(a), MPEP 711.03(c)(III)(D) affirmatively states that the USPTO “will require” (emphasis added) further information and showings. Accordingly, a Petitions Examiner is clearly given the discretion as to whether additional information will need to be required and/or considered for petitions filed under the unintentional standard of 37 CFR 1.137(b).

**Because Applicants filed a reply to a USPTO request within 1 year of the date of abandonment, the USPTO should withdraw its implicit holding that “there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional,” and should grant this Second Renewed Petition without the consideration of additional information.**

As an Examination policy, the USPTO does not generally question whether there is intentional delay if a petition under 37 CFR 1.137(b) is filed within three months of the notification of abandonment and within one year of the date of abandonment. *See* MPEP 711.03(c)(III)(D). While the Original Petition was indeed filed over one year after the date of abandonment, as set forth below, Applicants did attempt to correspond with the USPTO at least six times within one year of the abandonment of the application on July 18, 2000, yet were unable to gain information from the USPTO that the ‘641 application had abandoned. (O’Dowd Decl. ¶¶ 33-44; Altmiller Decl. ¶¶ 14-19; Neblett Decl. ¶¶ 4-7.)

Following the filing of a Continued Prosecution Application (CPA) on March 15, 2000 (O’Dowd Decl. ¶ 21), and the filing of a Preliminary Amendment on March 29, 2000 (O’Dowd Decl. ¶ 23), Applicants failed to receive a Notice of Allowance mailed on April 17, 2000 (O’Dowd Decl. ¶ 26). As a result, the ‘641 application became abandoned as a matter of law on July 18, 2000. Presumably because of concerns that a USPTO response had not been received by Applicants, Kenyon & Kenyon LLP (“Kenyon”) began a series of contacts and correspondences with the USPTO.

For example, less than six months after the abandonment date, on January 12, 2001, Cathy Ryan at Kenyon learned from a “[c]onversation w/ group receptionist” that the USPTO file for ‘641 was reported lost on November 27, 2000, the last known destination for the file being “the file repository.” Cathy Ryan also left a message with Examiner O. Hernandez at 10:45 AM. The

Examiner called back at 2:45 “to verify that file is in Depository.” There is no evidence the Examiner informed Cathy Ryan of the abandoned status of the application.<sup>5</sup> (O’Dowd Decl. ¶ 39.)

Less than one month later, on February 8, 2001, at least one Kenyon employee attempted to make copies of the file wrapper, but was informed that the file wrapper was lost. (See O’Dowd Decl. ¶ 40.) There is no evidence that this Kenyon employee was informed of the abandoned status of ‘641.

Less than nine months after the abandonment date, according to a paper and postcard retrieved from Kenyon’s files, a File Reconstruction request was stamped as received by “Licensing & Review” on March 23, 2001. (Nebblett Decl. ¶¶ 5-7.) The paper indicates:

We have been informed by the Office that the U.S. Patent and Trademark Office’s file for [‘641] has been lost. Please find attached a copy of the relevant documents forming the file history for this application from the applicant’s files for use in reconstructing the Office’s file.

Please reconstruct the file. Thank you for your attention to this matter. Please contact [Mark H. Nebblett (Reg. No. 42,028)], for any questions.

There is no evidence that the USPTO informed Applicants of the abandoned status of ‘641 in response to this submission.

Thus, at the time of these correspondences and communications, it was clear that Applicants’ were informed that the USPTO’s paper file was lost. (See also Nebblett Decl. ¶ 4.) Concerned with the results and speed of the USPTO search, Applicants’ undertook the effort and cost of providing the USPTO with a copy of Applicants’ file history for ‘641. (Nebblett Decl. ¶¶ 4-7.) After that step, Applicants’ reasonably believed that they had taken every step possible to move forward the prosecution of ‘641, and that the next step for moving forward the prosecution of ‘641 was in the USPTO’s hands.

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<sup>5</sup> Prior to this time, and after the date of abandonment, Kenyon filed three other correspondences during this general time period, all listing the correct address for Kenyon. (See O’Dowd Decl. ¶¶ 33-38.)

In light of the above, the USPTO should have no question that Applicants' made a good faith attempt to respond to known USPTO requirements within one year after the abandonment date. Applicants respectfully submit that such good faith efforts negate any USPTO presumption that a petition filed over one year after the date of abandonment requires the consideration of additional information. Accordingly, Applicants' respectfully request that the USPTO withdraw its implicit finding that "there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional," and grant this renewed petition without the consideration of additional information.

**While it is Applicants' position that additional information need not be considered by the USPTO for the granting of this renewed petition, Applicants' have made a good faith effort to provide additional information to the extent required by the USPTO**

The USPTO mailed a copy of the Dismissal to Applicants' on September 10, 2008. Applicants' attorneys had several questions regarding the Dismissal, and attempted to contact Examiner Walsh regarding the petition; however, Examiner Walsh was away from her usual examining functions for much of September and October (e.g., for extended training). On October 24, 2008, Applicants' attorneys were able to discuss the petition with Examiner Walsh. (O'Dowd Decl. ¶ 7.)

The primary concern of Applicants' was the Examiner's many requirements relating to "all persons . . . having firsthand knowledge of the circumstances surrounding the protracted delay," such as the requirement for statements and "[c]opies of any correspondence relating to the filing, or to not filing a further reply to the outstanding Office action." (See Dismissal at 2-3.) After a discussion with Examiner Walsh involving the facts and witnesses available to us at this time, Examiner Walsh indicated that especially in light of the fact that only the payment of an issue fee

was at issue in this case, it would not be necessary at this time to go to extraordinary measures to get statements from all persons having firsthand knowledge of the circumstances surrounding the delay. (O'Dowd Decl. ¶ 8.)

Nevertheless, Applicants have made extensive efforts in the preparation of this petition. Applicants have intensely examined the paper file wrapper of the '641 application to determine the identity of the various persons at Kenyon who worked on the prosecution of '641 application and to compile the many efforts by these Kenyon attorneys and staff to further prosecution of the '641 application. (*See, e.g.*, O'Dowd Decl. ¶¶ 9-18.) This investigation included contacting several former Kenyon employees, including, *inter alia*, an attorney who was no longer engaged in the active practice of patent law, and an attorney who worked for a law firm in Tokyo, Japan. Through contacting these former Kenyon employees, Applicants are able to provide further detail regarding the events which ultimately resulted in the delay in this case.

#### **A. Summary of Major Contributing Factors Causing Delay**

The first major contributing factor to the delay was the first (and only) change of address of Kenyon's Washington, DC office in or about March of 1999.<sup>6</sup> At that time, Kenyon moved its DC office from 1025 Connecticut Avenue, NW, to 1500 K Street, NW. (O'Dowd Decl. ¶ 19.) While Kenyon was eventually able to change the correspondence address for the many applications then handled by Kenyon's Washington, DC office, as of March of 2000, the USPTO

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<sup>6</sup> A March 1999 move date is partially evidenced by comparing Paper #8 and Paper #10 of the '641 application. Paper # 8, received by the USPTO on March 17, 1999, uses the 1025 Connecticut Avenue NW address. Paper #10, received by the USPTO on October 12, 1999, uses the 1500 K Street NW address. The March 1999 move date is also evidenced by the undeliverability of the April 17, 2000 Notice of Allowability (Paper #17), as evidenced by a paper stamped April 27, 2000 in the USPTO's '641 paper file. It is well known that the United States Postal Service (USPS) ceases the forwarding of mail one year after a move date. While Paper #17 was not forwarded to Kenyon's 1500 K Street NW address, an advisory action dated February 29, 2000 (Paper #13) was received by Kenyon, presumably from the USPS.

did not recognize the correspondence address of ‘641 as being 1500 K Street, NW.<sup>7</sup>

Correspondingly, as is clearly evidenced by a paper in the USPTO’s paper file, Applicants did not receive a Notice of Allowability for ‘641 which was mailed on April 17, 2000 (Paper #16). (O’Dowd Decl. ¶ 26.) Subsequently, the ‘641 application went abandoned, as evidenced by a Notice of Abandonment mailed by the USPTO on September 13, 2000 (Paper #17). (O’Dowd Decl. ¶ 30.)

A second major contributing factor to the delay was the departure of two key Kenyon attorneys in 2000. The Kenyon partner to whom ‘641 USPTO correspondence was addressed, Frank Pietrantonio, left employment with Kenyon on May 1, 2000. (O’Dowd Decl. ¶ 13.) In addition, the associate who appeared to have performed all of the prosecution work for ‘641, Sterlon Mason, left Kenyon on July 21, 2000. (O’Dowd Decl. ¶ 12.) The departure of these attorneys greatly reduced Kenyon’s institutional knowledge regarding ‘641.

A third major contributing factor to the delay was the temporary loss of the ‘641 file by the USPTO. According to a note in Kenyon’s ‘641 paper file, the USPTO reported the ‘641 file as lost on November 27, 2000. (O’Dowd Decl. ¶ 39.) Additional evidence that the ‘641 paper file was lost is provided by Paper #19 in the USPTO’s ‘641 file wrapper, i.e., while the Change of Correspondence Address document given the designation of Paper #19 is dated October 30, 2000, it was not entered until June 12 of some undetermined year (presumably 2001, 2002, or 2003). Kenyon was orally informed of the loss of the ‘641 file on January 12, 2001. (O’Dowd Decl. ¶ 39.) To confirm the loss of the file, on or about February 8, 2001, at least one of two Kenyon staff members having a Power to Inspect and Make Copies (signed by John C. Altmiller) personally traveled to the USPTO in an unsuccessful attempt to inspect the USPTO paper file. (O’Dowd

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<sup>7</sup> However, by that time, Papers #10, 12, 14, and 15 had been filed bearing the 1500 K Street NW address.

Decl. ¶ 40.) Subsequently, a File Reconstruction request, including a copy of the application as filed, was provided on or about March 23, 2001 to the USPTO by Mark H. Neblett of Kenyon. (Neblett Decl. ¶¶ 5-7.)

A fourth major contributing factor to the delay was the failure of the USPTO to respond to two Status Inquiry requests filed by Kenyon attorneys. (O'Dowd Decl. ¶¶ 45-47, 52-53; Altmiller Decl. ¶ 22.) These requests were filed on September 8, 2003 (signed by John C. Altmiller) and on September 15, 2004 (signed by William Curry). (*Id.*)

A fifth major contributing factor to the delay was the allowance of most or all of the co-pending foreign applications related to '641. While these related foreign applications were pending, Kenyon would periodically receive prior art from these foreign prosecutions which triggered the necessity of filing an Information Disclosure Statement (IDS). For example, an IDS was filed by Kenyon on September 9, 2004 which provided "references cited in the European Search Report of a related European Patent Application." (See O'Dowd Decl. ¶51.) It is believed that the filing of this IDS prompted the filing of the September 15, 2004 status request by William Curry. (See O'Dowd Decl. ¶ 52.)

A sixth major contributing factor to the delay was the departure of William Curry and John C. Altmiller from Kenyon in early 2007. (See O'Dowd Decl. ¶¶ 54-55.) Again, institutional knowledge regarding '641 was lost to Applicants.

Finally, a seventh major contributing factor to the delay relates to the limitations of the electronic docketing system currently utilized by Kenyon. Kenyon's electronic docketing system categorized the loss of the file by the USPTO as "PTO lost file-awaiting OA." (Russo Decl. ¶ 5.) Such has been the status of '641 in Kenyon's electronic docketing system since at least July 15, 2002. (*Id.*) Such a status conveys to a prosecuting attorney, particularly a prosecuting attorney

having no prior knowledge of ‘641, that no action need be taken since the USPTO is attempting to find and/or reconstruct the file. (Russo Decl. ¶ 6.) Furthermore, because the attorney is only “awaiting” an office action, there is nothing in the description to prompt the attorney to take immediate action.

## **B. Statements Obtained by Applicants**

Because of the circumstances surrounding the abandonment of ‘641, Examiner Walsh indicated to Applicants’ representatives that at this time, statements from all persons having knowledge of the circumstances surrounding the delay would not be required. Nevertheless, Applicants’ have obtained declarations from the following persons:

1. John C. Altmiller, a managing attorney of record for ‘641 from the date of its filing, until his retirement from Kenyon in 2007.
2. Mark H. Neblett, who filed a request to reconstruct the ‘641 file with the USPTO in March of 2001.
3. Judith M. Russo, the IP Support Coordinator for Kenyon’s Washington, DC office.
4. Shawn W. O’Dowd, a managing partner for ‘641 from the date of John Altmiller’s retirement from Kenyon in 2007.
5. Daniel G. Shanley, the attorney at Kenyon who first learned of the abandoned status of ‘641.
6. Ingrid Hodge, the Kenyon employee who first learned of the abandoned status of ‘641.
7. William E. Curry, a former Kenyon patent attorney who filed two Information Disclosure Statements and a Status Request in the 2003-04 time period.

### **C. Enumerated Facts Related to the Delay**

1. The USPTO mailed an Advisory Action regarding ‘641 to Kenyon on February 29, 2000. The address on the cover page of the Advisory Action listed Kenyon’s address as “1025 CONNECTICUT AVENUE NW.” (O’Dowd Decl. ¶ 18.)
2. On February 29, 2000, the offices of Kenyon were no longer located at “1025 CONNECTICUT AVENUE NW” in Washington, DC. Less than one year prior to February 29, 2000, in March of 1999, Kenyon had moved its offices to 1500 K Street, NW, also in Washington DC. (O’Dowd Decl. ¶ 19.)
3. As evidenced by an entry into Kenyon’s computerized docketing system, the Advisory Action of February 29, 2000 was received by Kenyon. (O’Dowd Decl. ¶ 20.)
4. In response to the Advisory Action, Applicants filed a Continued Prosecution Application (CPA) with the USPTO on March 15, 2000, along with a fee of \$800. The mailing of the CPA was entered into Kenyon’s computerized docketing system. (O’Dowd Decl. ¶ 21.)
5. The Transmittal Form for the CPA filed March 15, 2000 listed “1500 K Street, N.W.” as the address of Kenyon. (O’Dowd Decl. ¶ 22.)
6. On March 29, 2000, Applicants filed a Preliminary Amendment with the USPTO via facsimile. The Preliminary Amendment faxed to the USPTO on March 29, 2000 listed “1500 K Street, N.W.” as the address of Kenyon. (O’Dowd Decl. ¶ 23.)
7. On April 17, 2000, the USPTO mailed a Notice of Allowability to Kenyon at “1025 CONNECTICUT AVENUE NW” in Washington, DC. (O’Dowd Decl. ¶ 24.)
8. Prior to April 17, 2000, staff at Kenyon had been instructed to change the correspondence addresses of the many cases then prosecuted by Kenyon’s Washington, DC office.

However, by April 17, 2000, all cases had not yet been processed, including ‘641. (O’Dowd Decl. ¶ 25.)

9. The computerized docketing system at Kenyon does not reflect receipt of the Notice of Allowability by Kenyon. (O’Dowd Decl. ¶ 26.)

10. A copy of the “ISSUE FEE TRANSMITTAL” form is contained within the USPTO filewrapper for ‘641. The copy is not signed. Furthermore, the copy is stamped “MATCH & RETURN” and “RECEIVED APR 17 2000 TC 3600 MAILROOM.” (O’Dowd Decl. ¶ 27.)

11. The Notice of Allowability indicates that an issue fee of \$1210 was due on July 17, 2000. (O’Dowd Decl. ¶ 28.)

12. Docketing records at Kenyon do not reflect the payment of a \$1210 issue fee for ‘641. (O’Dowd Decl. ¶ 29.)

13. On September 13, 2000, according to a copy of a document retrieved from the ‘641 USPTO filewrapper, the USPTO mailed a Notice of Abandonment to Kenyon at “1025 CONNECTICUT AVENUE NW” in Washington, DC. The Notice of Abandonment was stamped with a message “ABANDONMENT CONTACT PERSON IS: TOM HAWKINS 305-8380.” (O’Dowd Decl. ¶ 30.)

14. There is no evidence in Kenyon’s files, nor in the ‘641 USPTO filewrapper that Tom Hawkins, or anyone else at the USPTO, attempted to contact Kenyon via telephone prior to mailing the Notice of Abandonment. (O’Dowd Decl. ¶ 31.)

15. Docketing records at Kenyon do not reflect the receipt of the Notice of Abandonment. (O’Dowd Decl. ¶ 32.)

16. On October 2, 2000, John C. Altmiller (Reg. No. 25,951) of Kenyon signed a Change of Correspondence Address changing the correspondence address of ‘641 to that of customer number 23838. (O’Dowd Decl. ¶ 33.)

17. According to a paper retrieved from the ‘641 USPTO filewrapper, the Change of Correspondence Address was stamped as received by OIPE on October 3, 2000, as received by Technology Center 2800 on October 4, 2000, and as received by Technology Center 2700 on October 6, 2000. There is no other evidence in the ‘641 USPTO filewrapper that the Change of Correspondence Address signed October 2, 2000 was considered by the USPTO. (O’Dowd Decl. ¶ 34.)

18. On October 30, 2000, Robert Hails (Reg. No. 39,702) of Kenyon transmitted by facsimile a second Change of Correspondence Address to Examiner Olga Hernandez. The second Change of Correspondence Address form indicated that future communications should be sent to John C. Altmiller of Kenyon at 1500 K Street, N.W. in Washington, DC. (O’Dowd Decl. ¶ 35.)

19. According to a paper retrieved from the ‘641 USPTO filewrapper, the second Change of Correspondence Address was stamped as received by Group 3600 on October 30, 2000. This paper is marked as paper #19, initialed by DRS, and dated June 12 of an unknown year (the retrieved copy reads “6-12-0” – the final number appears to have been cut-off upon copying). (O’Dowd Decl. ¶ 36.)

20. According to a paper retrieved from Kenyon’s files, an Associate Power of Attorney appointing “John C. Altmiller (Reg. No. 25,951) and other registered practitioners of Kenyon included in [Customer Number 23858]” was stamped as received by the USPTO on December 11, 2000. The paper, which had Kenyon’s New York office address at the bottom of

the page, is dated November 6, 2000, and is signed by Edward W. Greason (Reg. No. 18,918). (Altmiller Decl. ¶ 16.)

21. On January 12, 2001, Cathy Ryan at Kenyon learned from a “[c]onversation w/ group receptionist” that the USPTO file for ‘641 was reported lost on November 27, 2000, the last known destination for the file being “the file repository.” Cathy Ryan also left a message with Examiner O. Hernandez at 10:45 AM. The Examiner called back at 2:45 “to verify that file is in Depository.” A note written next to the record of the 10:45 message indicates “Power to Inspect.” (O’Dowd Decl. ¶ 39.)

22. According to a paper retrieved from Kenyon’s paper files, a “POWER TO INSPECT AND MAKE COPIES” was signed by John C. Altmiller on February 7, 2001. A hand written note on the top of the document indicates “LOST 1/16/01.” A sticky note signed by “Cathy” attached to the document indicates “Denise/Jay to go over 2/8/01.” (O’Dowd Decl. ¶ 40.)

23. According to a paper and postcard retrieved from Kenyon’s files, a File Reconstruction request was stamped as received by “Licensing & Review” on March 23, 2001. The paper indicates:

We have been informed by the Office that the U.S. Patent and Trademark Office’s file for [08/750,641] has been lost. Please find attached a copy of the relevant documents forming the file history for this application from the applicant’s files for use in reconstructing the Office’s file.

Please reconstruct the file. Thank you for your attention to this matter. Please contact [Mark H. Neblett (Reg. No. 42,028)], for any questions.

The paper was signed by Mark H. Neblett. The postcard is dated March 22, 2001. (Neblett Decl. ¶¶ 5-7.)

24. There is no evidence in the ‘641 USPTO filewrapper that the File Reconstruction request was considered by the USPTO. (O’Dowd Decl. ¶ 42.)

25. On July 15, 2002, an entry was made into the electronic docketing system at Kenyon indicating “PTO lost file-awaiting OA.” (O’Dowd Decl. ¶ 43.)

26. On July 31, 2003, Mark H. Neblett resigned from employment at Kenyon. (O’Dowd Decl. ¶ 44.)

27. On September 8, 2003, a postcard for a Status Inquiry for ‘641 was stamped as received by the USPTO. (O’Dowd Decl. ¶ 46.)

28. A paper entitled “STATUS INQUIRY” signed by John C. Altmiller is present in Kenyon’s paper files. The paper, which is dated September 8, 2003, “respectfully request[s] that the Examiner inform Applicants of the status of the application.” The paper further indicates that “The U.S. Patent and Trademark Office notified Applicants that the subject file had been lost and, accordingly, Applicants filed a copy of the relevant documents forming the file history in a File Reconstruction on March 23, 2001.” The paper also authorized the Commissioner to “charge any fee relevant to this filing to Kenyon & Kenyon Deposit Account No. 11-0600.” The paper has Kenyon’s 1500 K Street, N.W. address at the bottom of the page. (O’Dowd Decl. ¶ 45.)

29. There is no evidence in the ‘641 USPTO filewrapper that the Status Inquiry of September 8, 2003 was considered by the USPTO. (O’Dowd Decl. ¶ 47.)

30. According to a postcard retrieved from Kenyon’s files, an Information Disclosure Statement and accompanying papers was stamped as received by the USPTO (OIPE) on November 18, 2003. (O’Dowd Decl. ¶ 50; *see* Curry Decl., Exh. 2.)

31. An Information Disclosure Statement (IDS) signed by William E. Curry (Reg. No. 43,572) and dated November 18, 2003 is present in the ‘641 USPTO filewrapper. The IDS lists Kenyon’s 1500 K Street, N.W. address. The IDS is stamped as being received by Group 3600 on November 24, 2003. According to the IDS, as well as the cover of the ‘641 USPTO filewrapper,

the IDS was designated as Paper #20. The IDS indicates that the designation of “#20” was given on February 13, 2004 (“2/13/4”). (O’Dowd Decl. ¶ 49; *see* Curry Decl. Exh. 1.)

32. According to a postcard retrieved from Kenyon’s files, an Information Disclosure Statement and accompanying papers was stamped as received by the USPTO (OIPE) on September 9, 2004. (*See* Curry Decl., Exh. 4.)

33. An Information Disclosure Statement (IDS) signed by William E. Curry (Reg. No. 43,572) and dated September 9, 2004 is present in the ‘641 USPTO filewrapper. The IDS lists Kenyon’s 1500 K Street, N.W. address. The IDS is stamped as being received by Group 3600 on September 15, 2004. (*See* Curry Decl., Exh. 3.) According to the IDS, as well as the cover of the ‘641 USPTO filewrapper, the IDS was designated as Paper #21.

34. According to a postcard retrieved from Kenyon’s files, a Request for Status was stamped as received by the USPTO (OIPE) on September 15, 2004. (*See* Curry Decl., Exh. 6.)

35. A paper entitled “REQUEST FOR STATUS” signed by William E. Curry (Reg. No. 43,572) is present in Kenyon’s paper files. The paper, which is dated September 15, 2004, indicated:

A request for continued prosecution with an Information Disclosure Statement was filed in this case on 15 March 2000. A preliminary amendment was faxed to the Examiner on 29 March 2000. A change of correspondence address was filed on 30 October 2000. Thereafter, a copy of the entire file was submitted for re-construction of the lost file on 23 March 2001. A status inquiry was filed on 8 September 2003. Information Disclosure Statements were filed on 18 November 2003 and 9 September 2004, respectively.

It is respectfully requested that the undersigned [William E. Curry] be informed when an Office Action or other communication from the Patent Office may be expected in this case.

The paper has Kenyon’s 1500 K Street, N.W. address at the bottom of the page. (*See* Curry Decl., Exh. 5.)

36. There is no evidence in the ‘641 USPTO filewrapper that the Request for Status of September 15, 2004 was considered by the USPTO. (O’Dowd Decl. ¶ 53.)

37. In January 2007, William E. Curry’s employment ended at Kenyon. (O’Dowd Decl. ¶ 54.)

38. On July 31, 2007, John C. Altmiller resigned from employment at Kenyon. (O’Dowd Decl. ¶ 55.)

39. Contemporaneous with John C. Altmiller’s resignation, Shawn W. O’Dowd (Reg. No. 34,687) was docketed as the attorney responsible for ‘641. (O’Dowd Decl. ¶ 56.)

40. On June 27, 2008, Japanese patent counsel for Applicants’ faxed a letter to Kenyon inquiring as to the status of ‘641. The communication was addressed to William E. Curry. (O’Dowd Decl. ¶ 57.)

41. On July 10, 2008, Japanese patent counsel for Applicants’ faxed a reminder communication to Kenyon. (O’Dowd Decl. ¶ 58.)

42. After receipt of the July 10, 2008 communication, the file wrapper for ‘641 was forwarded to Daniel Shanley, a Kenyon associate who assists Shawn W. O’Dowd with numerous Toyota prosecution matters. (Shanley Decl. ¶ 5.)

43. Daniel Shanley, after reviewing the file wrapper, asked Ingrid Hodge to contact the USPTO regarding the status of ‘641. (Shanley Decl. ¶ 6; Hodge Decl. ¶ 4.)

44. Ingrid Hodge’s July 10, 2008 telephonic inquiry to the USPTO was eventually directed to Ms. Barr of the Office of Petitions. Ms. Barr alerted Ingrid Hodge as to the abandoned status of ‘641, and suggested that a “Petition to withdrawing of the Holding of Abandonment” be filed along with “docket records, etc.” (Hodge Decl. ¶ 5.)

45. Applicants filed the Original Petition on August 6, 2008. (O’Dowd Decl. ¶ 5.)

46. The USPTO mailed the Dismissal September 10, 2008. (O'Dowd Decl. ¶ 6.)

47. Applicants' attorneys had several questions regarding the Dismissal, and attempted to contact Examiner Walsh regarding the same; however, Examiner Walsh was away from her usual examining functions for much of September and October (e.g., for extended training). On October 24, 2008, Applicants' attorneys were able to discuss the petition with Examiner Walsh. (O'Dowd Decl. ¶ 7.)

48. The primary concern of Applicants' was the Examiner's many requirements relating to "all persons . . . having firsthand knowledge of the circumstances surrounding the protracted delay," such as the requirement for statements and "[c]opies of any correspondence relating to the filing, or to not filing a further reply to the outstanding Office action." (See Dismissal at 2-3.) After the discussion with Examiner Walsh on October 24, 2008 involving the facts and witnesses available to us at this time, Examiner Walsh indicated that especially in light of the fact that only the payment of an issue fee was at issue in this case, it would not be necessary at this time to go to extraordinary measures to get statements from all persons having firsthand knowledge of the circumstances surrounding the delay. (O'Dowd Decl. ¶ 8.)

49. The USPTO mailed the Second Dismissal on April 17, 2009.

50. Between approximately April 2009 and July 2009, as suggested by the Second Dismissal, Applicants attempted to contact Examiner Walsh regarding the Petition. (See Second Dismissal at 3 ("To expedite consideration, petitioner may wish to contact the undersigned regarding the filing of the renewed petition . . . [signed] /Liana Walsh/").)

51. In or about May 2009, Applicants were able to contact Examiner Walsh's assistant, Joan Olszewski; however, Examiner Olszewski was not able to provide any guidance regarding

particular information needed by the USPTO. It was the understanding of Applicants that Examiner Walsh was on extended leave at that time.

52. In June and July 2009, Applicants made renewed attempts to contact Examiner Walsh, believing that her extended leave had ended.

53. On July 13, 2009, Joan Olszewski contacted Applicants, indicating that she was assisting Examiner Walsh with this petition, and that she had no suggestions regarding particular information to be included in a renewed petition.

## DISCUSSION

It is respectfully submitted that the above facts clearly establish that “the delay in reply that originally resulted in the abandonment” represented unintentional delay on the part of Applicants. Applicants did not pay the issue fee of \$1210 by the due date of July 17, 2000, because they did not know that an issue fee was due by that date. (*See* Enumerated Facts ¶¶ 7-12.) As evidenced by the filing of a CPA, a \$800 fee, and a preliminary amendment within several months of the date of abandonment, it is clear that Applicants did not intentionally allow ‘641 to go abandoned. (*See* Enumerated Facts ¶¶ 4-6.) Furthermore, it is submitted that ‘641 went abandoned on July 17, 2000, despite the exercise of due care and diligence on the part of Applicants. Kenyon utilized a computerized docketing system, employed staff for docketing purposes, and had engaged in efforts to change correspondence addresses for their many pending patent applications. (*See, e.g.*, Enumerated Facts ¶¶ 8, 25; *see also* Russo Decl. ¶¶ 2, 4-5.) It was unfortunate, but unintentional, that Kenyon’s systems and internal processes failed to avoid the abandonment of ‘641.

It is also respectfully submitted that the above facts clearly establish that “the delay in filing an initial petition pursuant to 37 CFR 1.137(b) to revive the application” represented unintentional delay on the part of Applicants. Applicants did not file the Original Petition until August 6, 2008 because they did not know that ‘641 was abandoned until on or about July 10, 2008. (*See* Enumerated Fact ¶ 44.) Furthermore, it is submitted that Applicants were unable to discover the abandoned status of ‘641 at an earlier time, despite the exercise of due care and diligence on the part of Applicants. Kenyon utilized a computerized docketing system, employed staff for docketing purposes, and had engaged in extensive efforts to determine the status of ‘641. (*See, e.g.*, Enumerated Facts ¶¶ 8, 25; *see also* Russo Decl. ¶¶ 2, 4-5.) Despite Applicants’ efforts, the USPTO’s sole response to Applicants was that the file for ‘641 had been lost, and that efforts

were being made to find it. (*See* Enumerated Facts ¶¶ 16-21.) Concerned with the results and speed of the USPTO search, Applicants' undertook the effort and cost of providing the USPTO with a copy of Applicants' file history for '641. (*See* Enumerated Facts ¶ 23.) After that step, Applicants' reasonably believed that they had taken every step possible to move forward the prosecution of '641, and that the next step for moving forward the prosecution of '641 was in the USPTO's hands. (*See, generally,* the declarations by Neblett, Curry, Altmiller, O'Dowd, and Russo.) Accordingly, it was unfortunate, but unintentional, that Applicants' were unable to file an initial petition under 37 CFR 1.137(b) at an earlier date.

## **CONCLUSION**

### **1. Petition fee**

The Large entity fee of \$1,540.00 (37 CFR 1.17(m)) was paid in the Original Petition.

According to the Dismissal, no further petition fee is required for this renewed petition.

(Dismissal at 1.)

### **2. Proper Reply**

The copy of the proper reply is enclosed herewith, i.e., an Issue Fee Transmittal Form authorizing payment of a Utility Issue Fee of \$1510, i.e., the fee required as of FY2009. This form was originally transmitted to the USPTO on December 10, 2008. It is also noted that the Notice of Allowance required Formal Drawings to be filed including changes required by the PTO-948 attached to Paper #9. The PTO-948 required: 1) adjusting the top margin of Sheet 11; and 2) correcting the placement of figure legends on Figures 1 and 13. Replacement pages correcting these issues are enclosed.

### **3. Terminal Disclaimer with Disclaimer Fee**

Since this international application has an international filing date on or after June 8, 1995, no terminal disclaimer is required.

### **4. Statement**

The entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional.

### **5. Petition for One Month Extension of Time**

A petition for a one month extension of time under 37 CFR 1.316(a) is enclosed, thus extending the due date of this Renewed Petition to July 17, 2009.

In view of the above, favorable consideration of this Renewed Petition is respectfully requested. The Examiner is invited to call the undersigned at (202) 220-4200 to discuss any information concerning this Petition. The Office is hereby authorized to charge any additional fees under 37 C.F.R. § 1.16 or § 1.17 or credit any overpayment to Deposit Account No. 11-0600.

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Date: 17 July 2009



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Signature

Telephone  
Number: (202) 220-4200

Shawn W. O'Dowd  
(Reg. No. 34,687)

KENYON & KENYON LLP  
1500 K Street, N.W., Suite 700  
Washington, DC 20005

Enclosures:

- 1) Petition for One Month Extension of Time Under 37 CFR 1.316(a)
- 2) Issue Fee Transmittal Form (copy from December 10, 2008)
- 3) Formal Drawing Replacement Sheets
- 4) Seven Declarations (Altmiller, Neblett, Russo, O'Dowd, Shanley, Hodge, Curry), Incl. Exhibits.